

AMENDMENT AFTER FINAL ACTION

Appln. No. 10/686,353

Docket No. 066491-00007

**REMARKS**

Claims 1-3, 6-9, 11, 15-29, and 32-41 were pending in the application. Claims 1 and 27 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,446,448 to Whitman ("Whitman '448"). Claims 1-3, 6-9, 11-, 15-29, and 32-41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication 2002/0092203 to Hardt ("the Hardt '203 publication") in view of Whitman '448. Claims 6-7, 15-16, and 28-29 are cancelled with explanation (provided below). Claim 36 is cancelled without prejudice.

*Rejection of claims 1 and 27 under § 102(b) over Whitman '448*

Claims 1 and 27 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Whitman '448. Claim 1 has been amended to present the limitations of dependent claim 7 in independent form. Dependent claims 6-7 and 15-16 have been cancelled without prejudice, the dependent limitations being redundant in light of the amendment. Claim 27 has similarly been amended to present the limitations of dependent claim 29 in independent form. Dependent claims 28 and 29 have been cancelled without prejudice, the dependent limitations being redundant in light of the amendment.

*Rejection of claims 1-3, 8-9, 11, 17-27, 32-35, and 37-41*

Claims 1-3, 8-9, 11, 17-27, 32-35, and 37-41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Hardt '203 publication in view of Whitman '448. The Applicants respectfully argue that the present rejection does not establish a *prima facie* case of obviousness, as the reasoning presented by the Office lacks factual support in the record. When applying § 103, the references (1) must be considered as a whole and (2) must suggest the desirability and thus the obviousness of making the claimed combination. MPEP § 2141(II). The Applicants note that dependent claim 7, now presented in independent form as independent claim 1, and dependent claim 29, now presented in independent form as independent claim 27, both require

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first and second pads each having a rebound property, the rebound of the first pad differing from the rebound of the second pad. The Hardt '203 publication discloses an insole including an insole material/ sheet material 22, 32 that may be a substantially closed cell polymeric foam material, such as neoprene, and teaches that such materials are preferred because they provide excellent rebound or spring back characteristics when compressed and released. Hardt '203 publication at ¶0023. However, the publication is otherwise silent concerning rebound characteristics, disclosing that the first pad/arch plug 26 and second pad/heel plug 24 are a polyurethane elastomeric gel having very good cushioning and energy absorbing properties, and a urethane visco-elastic elastomer having excellent stability, low resilience and high tensile, tear and elongation properties. *Id.* at ¶¶0028 and 0029.

The Office admits that the Hardt '203 publication does not appear to disclose the rebound of the first pad differing from the rebound of the second pad, and suggests that Whitman '448 discloses an insole with a first and second pad where the rebound of the first pad differs from the rebound of the second pad "to prevent excessive rotation of the foot toward the outer border." Office Action mailed 10/20/2006 at pp. 3-4. However, it is clear that Whitman '448 does not disclose, teach, or suggest any information directly relating to a rebound property, and therefore cannot teach that a rebound property is altered to prevent excessive rotation of a foot toward an outer border. Instead, when considered as a whole, the reference teaches that an outer supporting element 16 "controls the degree of calcaneal twist imparted by the inclined inner border portion and thus prevents excessive rotation toward the outer border." Whitman '448 at col. 3 ll. 71-74. The patent discloses that the outer supporting element 16 is preferably made of a resilient material such as sponge rubber "so as to cushion the base of the fifth metatarsal as well as provide lateral support for the foot," *id.* at col. 3 ll. 40-43, but does not teach or suggest that a rebound property is a consideration in the stated cushioning and support, and does not incorrectly teach or suggest that resilience, i.e., the ability to return to an original shape, and rebound, i.e., the ability to return impact energy, are either interchangeable or directly correlatable to one another. Thus, the Office's stated rationale lacks a basis or support in Whitman '448, and is

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presumptively the result of a mistaken or impermissible hindsight analysis.

In addition, Whitman '448 clearly discloses that the problem cited by the office, i.e. "the calcaneal twist," is caused by the inclusion of an incompatible heel element 15. *Id.* at col. 3 ll. 27-29 ("The heel element, in particular, imparts what is commonly referred to as calcaneal twist to the heel."). Whitman '448 teaches that its heel element 15 is preferably made from a relatively non-resilient material such as hard rubber to provide firm support and prevent pronation of the foot. *Id.* at col. 3 ll. 12-17. However, the Hardt '203 publication teaches that its heel plug 24 is preferably made from a urethane providing very good cushioning and energy absorbing properties, and that the pad cushions a portion of a heel that is susceptible to heel pain due to compression and atrophy of the plantar fat pad and bone spurs. Hardt '203 publication at ¶0027. Thus, the hard Whitman '448 heel element is incompatible with the gelatinous Hardt '203 heel plug 24. The Office's argument with regard to former dependent claim 7 suggests that the heel element 15 would be eliminated in favor of the heel plug 24, but the elimination of that heel element would also eliminate the calcaneal twist cited by the Office, such that there would be no need to modify the Hardt '203 device. *See* Whitman '448 at col. 1 l. 52 to col. 2 l. 15. Thus, the Office's stated rationale also fails to properly consider the cited references as a whole, and fails to demonstrate a valid suggestion concerning the desirability and, thus, the obviousness of making the Applicants' claimed combination.

Finally, we note that with apparent reference to dependent claims 11 and 37, the Office has stated that the rebound of an article may be tuned to meet the needs of a particular user and/or a particular activity. A statement that a modification of the prior art would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. MPEP § 2141.01(IV). Correspondingly, a statement implying that a modification would have been within the ordinary skill of the art is not sufficient to establish a *prima facie* case of obviousness when the references

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relied upon fail to teach that an aspect of the claimed invention, such as a first (metatarsus) pad rebound being greater than a second (heel) pad rebound, is known in the art and fails to present an objective reason for adopting that particular modification. To establish a *prima facie* case of obviousness, all of the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03.

With particular respect to dependent claims 11 and 37, neither Whitman '448 nor the Hardt '203 publication are compatible with the problem solved by the Applicants' device. The Whitman '448 patent references corrective footwear designed to counteract a pronation caused by inward rotation and flattening of certain bones in the foot, and includes inclined arch and heel supports to reposition the foot. Whitman '448 at col. 1 ll. 24-44. The patent itself is directed to an outer support element that counters the effects of the aforementioned corrective structures. *Id.* at col. 1 ll. 52 to col. 2 ll. 15. In contrast, the Hardt '203 publication is directed to an insole specially constructed to address the concerns and needs of those who do not place a great deal of extraordinary stress on their feet from athletic activities, Hardt '203 publication at ¶0001 (2nd half), and providing cushioning, not rebound characteristics, to the heel and arch (including the first metatarsal head) of a foot, *id.* at ¶0002 (2nd half). However, dependent claims 11 and 37 are directed to an embodiment for use by a runner, wherein the rebound of the first (metatarsus) pad is greater than the rebound of the second (heel) pad, application at ¶0020, so that the insole or sole returns a relatively greater amount of the impact energy from a running foot to the foot to help it spring upward and forward. Thus, it is not surprising that references directed to the comparatively static problems of orthopedic correction or standing endurance neither disclose, teach, or suggest a solution to a dynamic problem addressed by providing a particular non-uniform rebound characteristic in the metatarsal and heel pads of an insole or shoe.

The Applicants note that dependent claims 7 and 29 have not been substantively amended, but merely offered in independent form to better present the issues identified above for appeal. The Applicants respectfully suggest that the finality of the present office action is premature due to the defects discussed above, and request that prosecution on the merits be

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reopened without resort to an appeal.

The Applicants' representative has submitted an amendment to claims 18 and 19 to correct a typographical error, and respectfully requests entry of this amendment on that basis. The Applicants' representative has also submitted amendments to claims 38, 39, and 41 to correct an erroneous recitation of the Applicants' preferred hardness ranges, and respectfully requests entry of these amendments as well. In view of the present references and rejections, claims 38-39 and 40-41 will rise or fall with independent claim 27 and dependent claim 37, respectively, should the application proceed to appeal.

*Conclusion*

In view of the foregoing remarks, the Applicants respectfully submit that the claims are allowable over the art of record and pray for a prompt allowance. This paper is being submitted on Monday, January 22, 2007, the nominal shortened statutory period having expired on Saturday, January 20, 2007, and thus we respectfully submit that no extension of time under 37 C.F.R. § 1.136(a) is due. MPEP § 710.05. The Commissioner is authorized to charge any additional fees required or to credit any overpayment to Deposit Account No. 20-0809.

Respectfully submitted,



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David R. Jaglowski  
Reg. No. 58,514

THOMPSON HINE LLP  
P.O. Box 8801  
Dayton, Ohio 45401-8801  
Telephone: (937) 443-6600  
Facsimile: (937) 443-6635  
E-mail: IPGroup@ThompsonHine.com  
464365.1